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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,456	04/06/2001	Stuart B. Levy	PKZ-030	6918

959 7590 07/10/2002

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

EXAMINER

HINES, JANA A

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 07/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,456

Applicant(s)

LEVY ET AL.

Examiner

Ja-Na A Hines

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10 are drawn to an isolated nucleic acid molecule, vector and host cell, classified in class 536, subclass 23.1.
 - II. Claims 11-12 are drawn to an isolated polypeptide, classified in class 530, subclass 324.
 - III. Claim 13 is drawn to an antibody, classified in class 424, subclass 130.1.
 - IV. Claim 14 is drawn to an agonist of BLR polypeptide, classified in class 424, subclass 116.
 - V. Claim 15 is drawn to an antagonist of a BLR polypeptide, classified in class 424, subclass 114.
 - VI. Claims 16-25 are drawn to a method for identifying compounds that modulate antibiotic resistance, classified in class 435, subclass 4.
 - VII. Claim 26 is drawn to a method for identifying a protein that interacts with a BLR nucleotide sequence, classified in class 435, subclass 6.
 - VII. Claims 27-28 are drawn to a method for identifying a compound that modulates the ability of a BLR nucleic acid molecule or polypeptide to interact with a BLR binding polypeptide, classified in class 435, subclass 7.8.

The inventions are distinct, each from the other because of the following reasons:

Art Unit: 1645

2. Inventions I and any of II, III, IV or V are related as different products. The products are distinct as claimed because they have different structures and different uses. Group I is drawn to an isolated nucleic acid; Group II is drawn to an isolated polypeptide; group III is drawn to an isolated antibody; group IV is drawn to an agonist; while group V is drawn to an antagonist. Each group has a different function, effect and is capable of use without the other. For instance, the isolated nucleic acid product of Group I can encode an antigenic polypeptide as opposed to the antibody product of group III that cannot encode such. No other group is drawn to an antibody that has the ability to elicit an immune response or bind to a particular antigen. Each group has a different structure, produces different effects and has a different function from the other group. Therefore, the products of the inventions are distinct as claimed.

3. Inventions VI and any of VII or VIII are related as methods. The methods are distinct as claimed because they have different methods with different method steps; different functions and the effects have different final outcomes. Group VI is drawn to a method for identifying compounds that modulate antibiotic resistance. Group VII is drawn to a method for identifying a protein that interacts with a BLR nucleotide sequence. Group VIII is drawn to a method for identifying a compound that modulates the ability of a BLR nucleic acid molecule or polypeptide to interact with a BLR binding polypeptide. The method of Group VII has a different function, i.e., for identifying a protein that interacts with a BLR nucleotide sequence, which is entirely different than identifying proteins that interact with BLR sequences or identifying compounds that modulate the ability of a BLR nucleic acid molecule or polypeptide to interact with a BLR

Art Unit: 1645

binding polypeptide. The method of group VII does not produce the same results. Each group produces different effects and different functions when compared to the other groups. Therefore, the inventions are unrelated.

4. The inventions of groups I-V are classified as products while groups VI-VIII are methods or processes of using the products are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case none of the methods claimed in groups VI-VIII require the use of any of the claimed products. Thus the process/methods can be practiced with other materially different products. Moreover, all of the products can be used with materially different processes such as a method for eliciting an immune response. Therefore, the products and processes are distinct.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-VIII, restriction for examination purposes as indicated is proper.

Art Unit: 1645


6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ja-Na A Hines whose telephone number is 703-305-0487. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on 703-308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Ja-Na Hines 
July 3, 2002


MARK NAVARRO
PRIMARY EXAMINER